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10/677,829	10/02/2003	Craig Ogg	61135/P024US/10303362	9780
29053 7590 03/28/2008 FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784				
EXAMINER				
VETTER, DANIEL				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/677,829

Applicant(s)

OGG, CRAIG

Examiner

DANIEL P. VETTER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-27 and 32-38 is/are pending in the application.
4a) Of the above claim(s) 32-37 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 14-27 and 38 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 1-31 were previously pending in this application. Claims 14, 21, and 23 were amended, claims 1-13 and 28-31 were canceled, and new claims 32-38 were added in the reply filed January 18, 2008. Claims 14-27 and 32-38 are currently pending in this application.

Response to Arguments

2. The renumbered claims overcome the objection and it is withdrawn.

3. Applicant's amendments overcome the rejections made to claims 15, 21, 23, and 25 under § 112, second paragraph, and they are withdrawn.

4. Applicant's arguments with respect to the rejections made under § 102(b) and § 103(a) have been fully considered but they are not persuasive. Examiner disagrees with applicant's limited interpretation of the Pierce reference and maintains that its disclosure fully teaches all limitations of claim 14 and therefore anticipates the invention. The configuration set forth in Pierce allows for greater functionality than the claimed invention, because each local postage account can act as a remote postage account in the event that a local account runs out of available funds (col. 4, lines 15-21). "Each Client PC has access, if authorized, to both its own local PSD(s), if any, and any other Client PC's PSD(s) ('remote PSDs') in the network." Pierce, col. 3, lines 30-34. "Thus, the transaction processing is performed remotely when a Client PC is accessing a remote PSD. In alternate embodiments, the logging of transactions is performed on a network server to which the Client PCs are connected ('Network Server PC')." Pierce, col. 3, lines 45-50. However, the conclusion does not follow that Pierce does not teach all positively recited limitations of the claims merely because the system in is also usable or disclosed in an embodiment that does not take advantage of that feature. Accordingly, because the claims are not limited to an embodiment that excludes the decentralized and flexible approach of Pierce, the reference properly anticipates the claims.

Election/Restrictions

5. Newly submitted claims 32-37 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
6. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 14-27 and 38, drawn to a method of accessing a remote postage account, classified in class 705, subclass 401.
 - II. Claims 32-37, drawn to a method of accessing a remote postage account, classified in class 705, subclass 401.

The inventions are distinct, each from the other because of the following reasons:

7. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as selecting a desired postage amount to be printed and printing the purchased postage. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

8. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-37 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 14-16, 18, 20-21, and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Pierce, et al., U.S. Pat. No. 6,151,591 (Reference A of the PTO-892 part of paper no. 20071012).
11. As per claim 14, Pierce teaches a method of accessing a remote postage account from a local postage evidencing device, comprising: connecting to a remote postage evidencing system via a local postage evidencing device (col. 5, lines 40-42), said local postage evidencing device having a local postage account (col. 5, lines 40-

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41); identifying a remote postage account on the remote postage evidencing system that is to be used to print postage on the local postage evidencing device (col. 5, lines 62-63); selecting a desired postage amount to be printed on the local postage evidencing device (col. 7, line 48); reducing a balance on the remote postage account (col. 5, lines 66-67) without transferring the value of the postage amount to the local account, thereby maintaining a same local postage account balance (col. 3, lines 45-50); and printing the desired postage amount on the local postage evidencing device (col. 8, lines 2-4).

12. As per claim 15, Pierce teaches the method of claim 14 as described above. Pierce further teaches printing the desired postage amount on the local postage evidencing device without reducing a balance on the local postage account (col. 6, lines 4-6).

13. As per claim 16, Pierce teaches the method of claim 14 as described above. Pierce further teaches authenticating a user with the remote postage evidencing system (col. 8, line 50).

14. As per claim 18, Pierce teaches the method of claim 14 as described above. Pierce further teaches connecting to the remote postage evidencing system using a wireline connection (col. 7, line 14).

15. As per claim 20, Pierce teaches the method of claim 14 as described above. Pierce further teaches the local postage evidencing device is a postage meter (col. 11, line 65).

16. As per claim 21, Pierce teaches the method of claim 20 as described above. Pierce further teaches the local postage account is a register that reflects the amount of postage that is currently authorized on the device (col. 10, lines 60-62).

17. As per claim 24, Pierce teaches the method of claim 14 as described above. Pierce further teaches the local postage evidencing device is a personal computer coupled to a printer (col. 5, lines 24-25).

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18. As per claim 25, Pierce teaches the method of claim 24 as described above. Pierce further teaches the local postage account is a stored value of postage that has been downloaded from an Internet-based postage service (col. 2, lines 47-49).

19. As per claim 26, Pierce teaches the method of claim 14 as described above. Pierce further teaches the remote postage evidencing system is an Internet-based postage service (col. 3, lines 51-55).

20. As per claim 38, Pierce teaches a method of accessing a remote postage account from a local postage evidencing device, said local postage evidencing device configured to selectively access a local postage account or a remote postage account, said method comprising:

accessing the remote postage account to purchase postage to be printed by the local postage evidencing device without accessing the local postage account (col. 8, lines 14-16); and printing the purchased postage using the local postage evidencing device (col. 8, lines 2-4).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, et al. in view of Cordery, et al., U.S. Pat. No. 5,454,038 (Reference B of the PTO-892 part of paper no. 20071012).

23. As per claim 17, Pierce teaches the method of claim 14 as described above. Pierce does not teach connecting to the remote postage evidencing system using a wireless connection; which is taught by Cordery (col. 14, line 65). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Cordery into the method taught by Pierce because a

wireless connection is a known equivalent to wired networks for communication (as taught by Cordery; col. 14, lines 64-67).

24. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, et al. in view of Lee, et al., U.S. Pat. No. 5,742,683 (Reference C of the PTO-892 part of paper no. 20071012).

25. As per claim 19, Pierce teaches the method of claim 14 as described above. Pierce does not teach identifying a user to the local postage evidencing device using a biometric input; which is taught by Lee (col. 8, line 22). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Lee into the method taught by Pierce because biometric data is a known manner of securely authenticating users, similar to a password (as taught by Lee; col. 8, lines 17-22).

26. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, et al. in view of Eddy, et al., U.S. Pat. No. 5,812,400 (Reference D of the PTO-892 part of paper no. 20071012).

27. As per claim 22, Pierce teaches the method of claim 14 as described above. Pierce does not teach the local postage evidencing device is a postage dispensing kiosk; which is taught by Eddy (col. 3, line 57). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Eddy into the method taught by Pierce in order to provide the increased functionality and utility to kiosk meter users (as taught by Eddy; col. 3, lines 57-59).

28. As per claim 23, Pierce teaches the method of claim 14 as described above. Pierce further teaches the local postage account is an amount of postage purchased by a user at the device (col. 5, line 41). Eddy further teaches the device is a kiosk which would be obvious for the same reasons as in claim 22 above.

29. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce, et al. in view of Bator, et al., U.S. Pat. Pub. No. 2002/0046193 (Reference E of the PTO-892 part of paper no. 20071012).

30. As per claim 27, Pierce teaches the method of claim 14 as described above. Pierce does not explicitly teach the remote postage evidencing system comprises a postage account established by the United States Postal Service; which is taught by Bator (¶ 0014). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Bator into the method taught by Pierce because the USPS historically is the entity that issues meter licenses so that proper accounting for postage can occur when mail items enter the USPS system at the point of origin (as taught by Bator; ¶¶ 0012-14).

Conclusion

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628